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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,476	03/05/2004	Thomas Dietiker	031193	2475

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EXAMINER

WINAKUR, ERIC FRANK

ART UNIT	PAPER NUMBER
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3735

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/708,476

Applicant(s)

DIETIKER, THOMAS

Examiner

Eric F. Winakur

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 and 22 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-21 and 27 is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-16, 22-26 and 28 is/are rejected.
- 7) ☒ Claim(s) 10 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

2. Claim 29 is objected to because of the following informalities: It appears that the phrase "a backing substrate ... and means for attaching the trans-illumination device to a patient" should be deleted, as these features are recited in claim 17, from which claim 29 depends. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 12 - 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is noted that Applicant has amended claim 11 to remove reference to a "means for attaching" but to retain the reference to a "means for affixing". Claim 12 has been amended to remove the reference to the "means for affixing" but recites elements that correspond to the means for affixing. As such, claim 12, and the claims that depend therefrom, include both a "means for affixing" and additionally, elements that perform this function. It is unclear why the claims include essentially duplicate structures claimed in this manner.

Claim Rejections - 35 USC § 103

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5. Claims 1 - 7, 11, and 22 - 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorski et al. in view of Saper et al. (USPN 5,090,410 - previously cited). Gorski et al. teach an oximeter sensor arrangement (column 4, line 14 - column 6, line 5) that includes all of the claimed features of the housing. Gorski et al. teach that the housing is attached to a liner 18 for attachment to a subject. Saper et al. teach an alternate attachment arrangement for a reusable sensor that includes a sleeve with an open end (considered a flexible strap having an aperture) for receiving a reusable sensor, such as that of Gorski et al. (see Figure 1; column 3, lines 5 - 11). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gorski et al. to use the attachment arrangement of Saper et al. since it has generally been held to be within the skill level of the art to substitute alternate arrangements for a device.

6. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorski et al. and Saper et al. as applied to claim 6 above, and further in view of Delonzor et al. The combination teaches all of the features of the claimed invention except that a copper conductive material is on the rear side of the detector. Delonzor et al. teach an oximetry sensor that includes a copper Faraday shield on the detector to limit electromagnetic interference (Figure 2 and description thereof). It would have been obvious to one of ordinary skill in the art at the time of the invention to implement Gorski et al. and Saper et al. with a copper Faraday shield on the detector, as taught by Delonzor et al., since this limits electromagnetic interference in the detected signal.

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7. Claims 25, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solenberger in view of Gorski et al. and Saper et al. Solenberger teaches a method to improve the durability of a sensor (particularly pulse oximetry sensors, such as that of the combination of Gorski et al. and Saper et al.) including removing adhesive (attaching means), performing processing, and associating the sensor with new attaching means (Figure 1 and description thereof). Further, when needed the sensor is cleaned and another attaching means is used (column 3, lines 35 - 42). It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the method of Solenberger with any oximetry sensor meeting the disclosed criteria, including that of Gorski et al. and Saper et al.

Response to Arguments

8. Applicant's arguments with respect to claims 1 - 9, 11, 22 - 26, and 28 have been considered but are moot in view of the new ground(s) of rejection. It is noted that Applicant has attempted to incorporate some, but not all, of the limitations of claim 12 into the various independent claims. This was not sufficient to define over the prior art, as detailed above.

Allowable Subject Matter

9. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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10. Claims 12 - 16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. Claims 17 - 21, and 27 are allowed.

12. Claim 29 would be allowable if rewritten or amended to overcome the objections set forth in this Office action.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric F. Winakur whose telephone number is 571/272-4736. The examiner can normally be reached on M-Th, 7:30-5; alternate Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ali Imam can be reached on 571/272-4737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric F Winakur
Primary Examiner
Art Unit 3735

12 December 2005